UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,845	03/04/2004	Tetsuo Yamaguchi	3673-0170P	5297

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EXAMINER
PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
3711	

NOTIFICATION DATE	DELIVERY MODE
02/21/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)	
Advisory Action ***Before the Filing of an Appeal Brief***	10/791,845	YAMAGUCHI ET AL.	
	Examiner	Art Unit	
	Sebastiano Passaniti	3711	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>31 January 2007</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

      Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ They raise the issue of new matter (see NOTE below);

   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

      NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: <u>*17-20, as stated in the final rejection, mailed10/31/2006*</u>.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

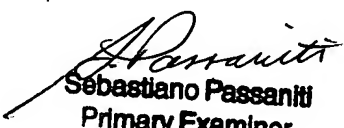<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). <u>11/16/06 (see cont.)</u>

13. ☐ Other: _____.

<p align="right">Sebastiano Passaniti
Primary Examiner</p>

Continuation of 11. does NOT place the application in condition for allowance because: the applicant contends that there is no teaching in the prior art that shows or obviates the inclusion of a maximum resilience point at locations spaced from the center of the hitting surface of the club head. Further, the applicant has indicated that just because the USGA test was designed to measure a (t2-t1) value at the center of the striking face, that this does not mean that the test cannot be used to measure properties of a club face away from the center. Moreover, the applicant contends that the combination of properties in claim 17, including the value of (t2-t1) and the claimed values for the x and y coordinates, together set forth a structure not shown or suggested by the prior art.

In response to these arguments, it is noted that the claimed term "resilience point" is being given the broadest, reasonable interpretation. Here, one would have to consider that the "point" is in essence a region or a specifically bounded area on the surface of the face. The claim makes no distinction as to how large or small this bounded area must be in relation to the remaining surface area of the clubface. If the applicant is attempting to distinguish the claimed invention disclosed by Zebelean by arguing that Zebelean shows a clubface reduction in thickness in a direction towards the crown of the head as opposed to a maximum resilience point spaced from the center of the hitting face, then it would appear that the applicant is arguing that the "point" of the claimed invention includes a single, distinct point that is completely different in thickness from all other points on the clubface. This would not only seem inaccurate based upon applicant's disclosure, but would also appear to be a very misplaced interpretation of the claim language. As for arguments relating to the USGA Rules for the pendulum test, which are referenced in both the rejection of the claims and the applicant's response, it is noted that the results (i.e., values of x, y and (t2-t1)) that the applicant asserts are not shown or obviated by the prior art do not in fact provide any further structure to the claimed club head, as it is inaccurate and almost without meaning to express a value such as (t2-t1) in this case while attempting to use a test that is not designed to measure a club face property away from the center of the hitting face. In other words, the claimed values for "x" and "y" can not considered critical when the test related to these values produces a result for t2-t1 that holds no meaning outside of the center of the hitting face. As an analogous argument, consider the following: A "standard" blood pressure cuff is designed to be placed about a person's arm and inflated, after which readings for systolic and diastolic pressures may be recorded and compared with known, acceptable ranges of blood pressure. The identical cuff can most certainly be placed around a person's calf and inflated and used to obtain some "value". To say that this "value" means anything within the context of normal or standard blood pressure measurement would be somewhat misplaced.

Continuation of 12: The information disclosure statement filed 11/16/06 fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). A statement under 37 CFR 1.97(e) must state either (1) that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the statement. Applicant has provided a statement that states that "[e]ach item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than 30 days prior to the filing of this IDS". This statement is not one of the two statements acceptable under §1.97(e). The IDS has been placed in the application file, but the information referred to therein has not been considered.

Sebastiano Passaniti
Primary Examiner